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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/699,984

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EXAMINER

JOHNS, CHRISTOPHER C

ART UNIT

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3621

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/699,984	<b>Applicant(s)</b> AIDA ET AL.	
	<b>Examiner</b> Christopher C. Johns	<b>Art Unit</b> 3621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Acknowledgements***

1. Claims 1-18 are pending.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-18 rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent Application Publication 2001/0034846 ("Beery") in view of United States Patent 7,203,966 ("Abbur").

4. As per claims 1-18, Beery teaches:
  - a. server (figure 2, reference numbers 40, 42) operable to provide software via a network (reference numbers 50-59) to a plurality of electronic devices (reference number 44);
  - b. at least two electronic devices, identified by device identification information (figure 5b, reference numbers 232, 233, 236) associated with user identification (figure 5b, reference numbers 214, 218) information identifying a single user such that each of the devices have the same user (Beery may not explicitly state that a single user can own multiple devices in the system, a highly well-known and very old idea to those skilled in the art at the time of the invention (especially in arts such as DRM home networks, etc).

Abburi covers a digital rights management system whereby users may possess “several computers...at which the user may wish to access the content for which the user has a license” (column 2, lines 33-45). Abburi further teaches how a “user might obtain a license to play certain music on a work computer and then listen to that music from the user’s home computer...without purchasing a duplicate license”. It does this to create a more robust and convenient system – as it obviates the issues which would necessitate purchasing a license twice. See also figure 25 (reference numbers 1302a-c), figure 3, and figure 8. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the system described in Abburi for associating multiple devices with one user, in the system described in Beery, as it would provide a more convenient system, due to the ability to use the same purchased content on similarly-registered (but physically different) devices, something that a person having ordinary skill in the art would understand as advantageous);

c. first requesting means for sending user, device, and software identification information to the server to request that selected software be provided (figure 5b, reference numbers 214, 230, 233, 236, 248, 250);

d. installing means for installing selected software (figure 5b, reference number 252);

e. second requesting means for sending software, user, and device identification information to request that a license be generated based on predetermined license generating information, generating means for generating license when software, user, and

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device information have been registered in association with each other (figure 5b, reference numbers 240, 242, 244, 246, 248);

f. running means for running software (inherent in the art of computing);

g. third requesting means for requesting server transfer software from electronic device to another device which has the same user associated therewith (Abburi teaches transference of licenses, see column 66, lines 36-63 – “...if a user de-registers a device from the license synchronization server, original licenses obtained from the de-registered device are removed from the license store on the synchronization server and the “do not use” indicators on the original licenses on the de-registered device are removed...”. It may not explicitly state that the files themselves are transferred, but as the files are associated one-to-one with the license, the Examiner contends that it would be obvious to transfer the program/associated data along with the license, as without a license the data cannot be used);

h. It is the examiner’s primary position that the claims are anticipated because sending the license as well as the data associated with the license would be obvious, given that the license itself is already sent. However, if not obvious, then the Examiner contends that Microsoft Windows and MS-DOS teaches that if a user wishes to transfer software (and its associated license), it must be done “on a permanent basis”, by transferring “all copies of the SOFTWARE”. (End-User License Agreements were old and well-known to those skilled in the art at the time of the invention (see, for example, Microsoft Computer Dictionary entry for End-User License Agreement)).

i. While, as stated, Beery does not explicitly teach automatic transfer of licenses, it would be obvious to one skilled in the art at the time of the invention to implement a system to transfer said licenses between users. Merely providing an automatic means (the system described in the instant application) to replace a manual activity (in this case, manual transfer of software and licensing), where the automatic means accomplishes the same result, is not sufficient to distinguish over the prior art<sup>1</sup>. A simple automation of the process of transferring “all copies of the software” as well as the license has the same result as manually performing said process. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to automate the license transfer because the process would be accomplished more quickly, but the result is exactly the same.

i. authentication based on user and device information (figure 5b, reference numbers 214, 220, 232, 233, 236, 250);

j. registering means for registering the software information in association with the device and user information on condition that the user and device information have been registered in association with each other (Abburi, column 4, line 51+ - “synchronized licenses so that all the computers enrolled in the service belonging to or used by a particular user have the same set of licenses...a user connects to the licenses synchronization server and registers all devices owned by the user that the user wants to roam...”);

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<sup>1</sup> *In re Venner*, 120 USPQ 192, 194; 262 F.2d 91 (CCPA 1958).

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k. providing means for providing selected software to respective electronic device, transferring means for deleting software identification information for the software, user, and device information registered in association with software information, registering software information in association with the device information for another electronic device and user information (figure 5b, 250).

### ***Response to Arguments***

5. Applicants' arguments with respect to claims 1-18, on pages 12-13 have been considered but are moot in view of the new ground of rejection. Applicants appear to argue limitations that were not previously in the claims – as they have been fully addressed in this Office Action, the arguments are overcome.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- l. United States Patent 6,920,567 B1 (Doherty et al);
- m. United States Patent 7,047,411 B1 (Demello et al);
- n. United States Patent Application Publication 2003/0226012 A1 (Asokan et al);
- o. United States Patent Application Publication 2003/0187801 A1 (Chase et al);
- p. United States Patent Application Publication 2002/0035697 A1 (McCurdy et al);
- q. United States Patent 6,009,401 A (Horstmann);
- r. United States Patent 5,925,127 A (Ahmad);

- s. United States Patent 5,715,403 A (Stefik);
- t. United States Patent 5,629,980 A (Stefik et al);
- u. United States Patent 4,999,806 A (Chernow);

7. **Examiner's Note:** Although Examiner has cited particular columns, line numbers and figures in the references as applied to the claims above for the convenience of the applicants, the specified citations are merely representative of the teaching of the prior art that are applied to specific limitations within the individual claim and other passages and figures may apply as well. It is respectfully requested that the applicants, in preparing the response, fully consider the items of evidence in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

8. Applicants' amendment necessitated the new ground of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

9. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.



10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher C. Johns whose telephone number is (571)270-3462.

The examiner can normally be reached on Monday - Friday, 9 am to 5 pm.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner  
Art Unit 3621

CCJ

/ANDREW J. FISCHER/  
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